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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,119

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EXAMINER

CHU, KIM KWOK

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,119	Applicant(s) TALSTRA ET AL.	
	Examiner Kim-Kwok CHU	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on March 1, 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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35 U.S.C. 101 Rejection

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13 and its dependent Claim 14 are drawn to a computer readable memory medium as recited in the preamble and as such is non-statutory subject matter.

The USPTO recognizes that applicants may have claims directed to computer readable media that cover signals per se, which the USPTO must reject under 35 U.S.C. § 101 as covering both non-statutory subject matter and statutory subject matter. In an effort to assist the patent community in overcoming a rejection or potential rejection under 35 U.S.C. § 101 in this situation, the USPTO suggests the following approach. A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. Cf. *Animals - Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987) (suggesting that applicants

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add the limitation "non-human" to a claim covering a multi-cellular organism to avoid a rejection under 35 U.S.C. § 101). Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals per se. The limited situations in which such an amendment could raise issues of new matter occur, for example, when the specification does not support a non-transitory embodiment because a signal per se is the only viable embodiment such that the amended claim is impermissibly broadened beyond the supporting disclosure. See, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).

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Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2 and 5-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding the amended Claim 1, lines 4 and 5, the amended phrase "content protection information comprises a pointer to a storage location of a key block stored in said initial zone for protection of said content stored in said side channel in a pre-groove in said data zone" is vague. Accordingly, the claimed content protection information is stored in the data zone (line 1) and side channel (line 2), on the other hand, the pointer is stored in the initial zone. Such storage arrangement in the record carrier is not clear as whether or not the claimed data zone (line 1) comprises the main channel or both the main channel and the side channel. Similarly, it is also not clear whether or not the claimed initial zone (line 1) comprises the side channel or both the main channel and the side channel. Furthermore, it is not clear whether or not the claimed pre-groove in the data zone (last second line) meant a track

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containing pre-recorded information or just a track for recording information.

Similarly, in each of Claims 9-13, the storage arrangement of the record carrier is vague because it is not clear whether or not the claimed data zone comprises the main channel or both the main channel and the side channel. Similarly, it is also not clear whether or not the claimed initial zone comprises the side channel or both the main channel and the side channel. And furthermore, it is not clear whether or not the claimed pre-groove in the data zone (meant a track containing pre-recorded information or just a track for recording information).

The claims not specifically mentioned above are rejected because these claims are dependent on the rejected base claims.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 1, 2 and 5-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tosaki et al. (U.S. Patent 6,633,534).

6. Tosaki teaches a recording carrier having all of the structures as recited in claims 1, 2 and 5-8. For example, Tosaki teaches the following:

Regarding to Claim 1, the record carrier 1 (Fig. 1A) having a data zone 4, 5 (Fig. 1A and 2; zones 4 and 5 are used to record data and therefore considered as a data zone) and an initial zone 3, 4 (test zone 3 and pre-groove 4 can be considered as initial zone) and comprising a main channel (main user information) storing content (recording information in tracks 7 in data zone 5); and a side channel (supplementary information such as lead-in information; column 2, lines 39-42) storing address information and data relevant for making recordings (management information stored in lead-in 4 includes address information), wherein content protection information

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(key for copyright) comprises a pointer (index) to a storage location 9 (pre-pits) of a key block (column 7, lines 24-26) stored in the initial zone 4 (pre-groove) for protection of the content (main recording information in data zone 5) is stored in the side channel (supplementary information) in a pregroove 8, 9 in the data zone 4 (Fig. 2; pre-grooves are recordable tracks during disk manufacturing/stamp process), wherein the main channel (main information) is for recording information in the data zone 5 (column 2, lines 45-52).

Regarding Claim 2, the content protection information comprises a key block 9 (Fig. 2; key storage area such as prepits; column 7, lines 23-34).

Regarding Claim 5, wherein the content protection information (key) is stored as a part of the address information (Fig. 1B; part of the lead-in information in zone 4).

Regarding to Claim 6, wherein the record carrier is a DVD+R disc or a DVD+RW disc and the side channel is an ADIP side channel (Fig. 1A and 1B; column 6, lines 30 and 31; DVD includes DVD+R).

Regarding to Claim 7, wherein the record carrier 1 is a DVD-R disc or a DVD-RW disc and the side channel is a LPP (land prepits) side channel (column 3, lines 1-3).

Regarding Claim 8, wherein the record carrier is a DVD and

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a copy of the content protection information (key) is stored in a buffer zone in a lead-in zone 4 of the record carrier (Fig. 2; prepits/pregrooves are buffer zones to store buffer/additional information).

7. Method claim 9 is drawn to the method of using the corresponding apparatus claimed in claim 1. Therefore method claim 9 corresponds to apparatus claim 1 and is rejected for the same reasons of anticipation as used above.

8. Claim 10 has limitations similar to those treated in the above rejection, and is met by the reference as discussed above.

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9. Tosaki teaches an apparatus for reading out protected content stored on a record carrier having all of the elements and means as recited in claim 11. For example, Tosaki teaches the following:

Regarding to Claim 11, the record carrier 1, (Fig. 1A) having a data zone 4, 5 and an initial zone 3, 4 (Fig. 1B) and comprising a main channel (main information) storing content (main recording data in zone 5) and a side channel (lead-in information stored in zone 4) storing address information and data relevant for making recordings (Fig. 1B; column 7, lines 14-23), the apparatus comprising means 31 (Fig. 11; DVD player; column 15, lines 43-45) for reading out of the protected content, means 31 for reading out of content protection information comprising a pointer (index/address) to a storage location 9 (pre-pit) of a key block stored in the initial zone 3, 4 (pre-pit is an initial zone) for protection of the content (Fig. 11), the content protection information (key) stored in the side channel (zone 4) in a pregroove in the data zone 4, 5 (Fig. 2), means 35 decrypting the content using the content protection information (Figs. 10 and 11), where the main channel is for recording information in the data zone 5 (Fig. 1B).

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10. Method claim 12 is drawn to the method of using the corresponding apparatus claimed in claim 11. Therefore method claim 12 corresponds to apparatus claim 11 and is rejected for the same reasons of anticipation as used above.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 13 and 14 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Tosaki et al. (U.S. Patent 6,633,534) in view of Ciacelli et al. (U.S. Patent 6,236,727).

Tosaki teaches a computer controlled record carrier player very similar to that of the present invention. For example, Tosaki teaches the following: a computer performing (Figs. 11 and 12; optical disk is controlled by a computer means) storing content in a main channel (main information in zone 5), storing address information and data relevant for making recordings in a side channel (Fig. 1B; column 7, lines 14-23); and storing

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content protection information for protection of the content in the side channel (side information stored in zone 4) in a pregroove in a data zone 4, 5 (Fig. 2; pregrooves are recordable tracks), wherein the content protection information is used for protecting the content 5 (Figs. 10 and 11), wherein the main channel is for recording information in the data zone 4/5 (Fig. 1B).

Regarding Claim 14, decrypting the content using the content protection information; and outputting the decrypted (authorized) content (Fig. 10; key is being read and data is authorized to read/copy).

However, Tosaki does not teach the following:

Regarding Claim 13, a computer program stored on a computer readable memory medium, the computer program comprising computer program code means for causing a computer to perform the above acts when the computer program is run on a computer.

Ciacelli teaches a computer program stored on a computer readable memory medium, the computer program comprising computer program code means for causing a computer to perform disk operations when the computer program is run on a computer (Fig. 1).

To perform an optical disk operations such as recording/reproducing data, a set of procedures are written

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accordingly and then stored in a memory medium/device in order to control the disk. In such case, although Tosaki does not disclose his disk read/write is controlled by a computer, it would have been obvious to one of ordinary skill in the art to use Ciacelli's computer control means having disk operating procedures/programs stored in a computer readable memory in Tosaki's optical disk apparatus, because the procedures can be written to performs various disk controlled operations by updating the procedures/programs instead of changing the disk electrical circuits.

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Response to Remarks

13. Applicant's Amendment and Remarks filed on March 12, 2010 has been fully considered.

The claimed features "data zone, "initial zone", "main channel" and "side channel" in each of Claims 1, 9-13 are considered not clear and rejected under 35 U.S.C. 112, second paragraph which is inadvertently missed in the last Office Action dated December 9, 2009.

In the previous rejection, the cited prior art of Tosaki et al. (U.S. Patent 6,633,534) is cited and its data zone 5 (Fig. 2) anticipated Applicant's claimed data zone in Claim 1. However, with an alternative interpretation, the cited prior art's zones 4 and 5 (Fig. 2) are now considered as a data zone in the present rejection. Since Tosaki's zones 4 and 5 are considered as the data zone, the "copy management key information" in zone 4 is a side channel/information located in the data zone (Fig. 2) similar to Applicant's "content protection information" as claimed in Claim 1.

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14. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

/Kim-Kwok CHU/
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May 21, 2010
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Supervisory Patent Examiner, Art Unit 2627